

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS VONDRACEK
and HEINZ KROBER

Appeal No. 96-4172
Application 08/098,594¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*,
ABRAMS and PATE, *Administrative Patent Judges*.

PATE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
16, 17, 19 through 22 and 28 through 30. These are the only
claims remaining in the application.²

¹ Application for patent filed July 28, 1993.

² As far as can be determined by the Board, a response
to the final rejection was received August 30, 1995, from
appellants. The response was responded to by the examiner
(continued...)

The claimed invention is directed to an apparatus for hot coiling curved helical springs. A curved helical spring is one in which the central axis of the spring is bent. With reference to Figure 1, the apparatus includes a kiln **1** for heating rod stock, and a roller conveyor **2,3** which conveys the hot rod to a coiling bench **4**. The coiled hot rod **4** is conveyed to a spring curving tool **5** which curves the spring and submerges the spring into the quenching tub **6**.

Claim 28, reproduced below, is further illustrative of the claimed subject matter.

28. Apparatus for manufacturing hot-coiled helical springs with a bent major central axis that are curved when unstressed from sections of wire or rod, comprising: heating means for heating sections of wire or rod to coiling temperature; coiling means communicating with said heating means for coiling the heated sections and forming a straight spring; curving mean downstream of said coiling means for receiving said straight spring from said coiling means for curving said spring to a specific shape taken by said spring when in the unstressed state; said coiling means having a kiln, rollers, and a coiling bench, said rollers conveying the heated sections from said kiln to said coiling bench; a quenching tub communicating with said curving means for quenching said spring after leaving said curving means; said curving means curving helical springs between said coiling bench and said quenching tub; a drum rotating over said tub and partially immersed in said tub, said curving means comprising a

²(...continued)

in an Advisory action mailed on October 26, 1995. Evidently, the August response to the final rejection did not include any amendments to the clams. These papers are missing from the file.

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plurality of spring-curving tools distributed around said drum and immersed into said tub by said drum, said kiln, rollers, and coiling bench forming a hot-coiling production line, said central axis being bent as a whole even when free of load.

The references of record relied upon by the examiner as evidence of obviousness are:

Hobracht	1,816,377	July 28, 1931
Widgren	2,218,864	Oct. 22, 1940
Bayerische Motoren Werke (Great Britain)	1,198,713	July 15, 1970

Claims 16, 17, 19-22, and 28-30 stand rejected under 35 U.S.C. § 103 as unpatentable over Widgren in view of the British patent to BMW and Hobracht.

According to appellants, the claims do not stand or fall together. However, the appellants have not provided separate arguments with respect to the claims on appeal, excepting claim 19, which was separately argued on page 5 of the brief. Consequently, all claims, excepting claim 19, are held to stand or fall with claim 28.

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellants and the examiner. As a result of this review, we have determined that the prior art does not establish a **prima facie** case of obviousness with respect to the

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subject matter of the claims on appeal. Therefore, the rejection of these claims on obviousness grounds is reversed. Additionally, pursuant to our authority under 37 CFR § 1.196(b), this Board enters rejections under 35 U.S.C. § 112, first and second paragraphs.

It is the examiner's finding of fact that Widgren teaches a means for "forming, tempering, flattening, bending, and cooling the helical springs" (examiner's answer, page 3). Apparently, this finding comes from the first sentence of Widgren's specification. However, we must note that Widgren relates to forming and tempering a helical spring only to the extent that the spring is formed by flattening the end coil portions so that the ends of the spring lie in a transverse plane to the spring's axis. See column 2, lines 5 through 16. In fact, Widgren does not disclose forming a coil spring from a rod stock. The fact that Widgren is only concerned with flattening the ends of the spring and not coiling the stock can be seen with reference to column 1 of page 3, lines 69 through 73. Therein, Widgren discusses that the spring is formed by flattening the ends. We further note that the Hobracht patent which deals with leaf springs and the British patent to BMW also are not concerned with coiling a proto-spring from a rod stock. Thus, the combined

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references, when considered collectively, do not teach the coiling means of appellants' independent claims on appeal. The examiner and appellants reached this issue when they argued about whether Widgren hot coils or cold coils the rod stock. Since a coiling means is not disclosed in Widgren, it is impossible to state, without making assumptions, whether Widgren uses cold work or hot coiling to form the springs. Since the combined references do not teach the claimed coiling means, the examiner has not established a **prima facie** case of obviousness with respect to the subject matter of the claims on appeal. The obviousness rejection of these claims must be reversed.

Pursuant to our authority under 37 CFR § 1.196(b), this Board enters the following rejections.

Claims 16, 17, 19 through 22, and 28 through 30 are rejected under 35 U.S.C. § 112, first paragraph, as based on disclosure which lacks descriptive support of the claimed invention. If a person of ordinary skill in the art would have understood the inventor to have been in the possession of the claimed invention at the time of filing the description requirement is met. **In re Alton**, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996). Precisely how close the original description must come to comply with the description requirement must be decided on a case-by-

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case basis. *Id.* at 1172, 37 USPQ2d at 1581 (*quoting Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995)). The three independent claims on appeal call for a heating means for heating sections of wire or rod to coiling temperature and coiling means communicating with said heating means for coiling the heating sections to form straight springs. Subsequently, these same claims recite that the coiling means has a kiln, rollers, and a coiling bench. With reference to Figure 1, there is no disclosure in the drawings or in the written specification of both a heating means and a kiln which forms part of the coiling means. In fact, these two means for heating would appear to be entirely redundant. At any rate, appellants' disclosure does not convey the possession of a heating means and a coiling means having its own separate kiln. For this reason, the claims fail to comply with the description requirement of 35 U.S.C. § 112, first paragraph.

Claims 16, 17, 19 through 22 and 28 through 30 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter appellants regard as the invention. In view of the fact that all three independent claims on appeal are directed to the subject matter of a heating means and a coiling means, with said coiling

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means having its own kiln, these claims are misdescriptive or inaccurate with regard to the subject matter that appellants regard as the invention. Appellant's claims improperly define the kiln as part of a coiling means. However, according to appellant's disclosure the only structure which performs the coiling function is the coiling bench which does not include a kiln. These claims, which also specify the additional heating means, are misdescriptive of the invention as disclosed.

SUMMARY

The rejection of claims 16, 17, 19 through 22 and 28 through 30 under 35 U.S.C. § 103 has been reversed. Pursuant to our authority under 37 CFR § 1.196(b), we have entered a rejection of claims 16, 17, 19 through 22 and 28 through 30 under 35 U.S.C. § 112, first and second paragraphs.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, ***WITHIN TWO MONTHS FROM THE DATE OF THE DECISION***, must exercise one of

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the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 CFR § 1.196(b)

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
WILLIAM F. PATE, III)	
Administrative Patent Judge)	

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Max Fogiel
61 Ethel Road West
Piscataway, NJ 08854

WFP/cam